REMARKS

Claims 49-81, 83-111 and 118-124 are pending in the present application. Reconsideration is respectfully requested for the reasons discussed below.

The invention as claimed is based on the surprising discovery that a coating giving outstanding crispness, mouth feel and hold time can be obtained without using substantial amounts of corn starch. Surprisingly, this can be accomplished by using a rice component and a dextrin component in particular ratios and within a particular range.

Thus, the various claims now pending require coating compositions or their use having varying specified quantities and ratios of a rice component and a dextrin component, wherein the composition is "substantially free of corn starch" (independent claims 49, 92, 111 and 119), or has "about 0% corn starch" (claim 118), or "is free of corn starch" (claims 120-123).

Final Rejection Mailed November 26, 2003

In the final rejection mailed November 26, 2003, the Examiner rejected claims 49, 92 and 111 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The Examiner stated, "[i]n claim 49, the language 'substantially free of corn starch' is indefinite because the scope of the claim cannot be ascertained. It is not known how much corn starch can be present and the specification does not define what 'substantially free' mean [sic]. Page 8 of the specification discloses 10% or even more corn starch ingredient *may* be used. (Emphasis added). Thus, it is not clear what 'substantially free' constitute [sic]. Claims 92 and 111 have the same problem as claim 49."

The Examiner also rejected claims 49-51, 55-57, 61-63, 73-75, 77-79, 81-85, 88-90, 92-98 and 111 under 35 U.S.C. §102(e) as being anticipated by Horn et al. (6,080,434). The Examiner stated, "[t]he reference discloses all the limitations of the above cited claims."

Additionally, claims 49-111 were rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The Examiner stated, "[t]he claim(s) contain subject matter which was not described in the specification in such a way as to

reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention." The Examiner further stated, "claims 49, 92, 111 contain the limitation 'substantially free of starches made from plants crossbred or modified to contain either the dull sugary 2 genotype of the amylose extender dull genotype'." The Examiner also rejected claim 111 stating, "claim 111 is unclear in that it is not known what method applicants are claiming because the claim only recites 'a method comprising'; a method of what?."

Lastly, the Examiner stated, "[c]laims 52-554 [sic], 58-60, 64-72, 76, 80, 86-87, 91, 99-110 are rejected under 35 U.S.C. §103(a) as being unpatentable over Horn et al." In support of this position, the Examiner listed several blanket statements without citing any prior art reference asserting the claimed subject matter would have been obvious to one of ordinary skill in the art.

Applicants' January 29, 2004 Response

On January 29, 2004, Applicants responded to the Examiner's final rejection requesting reconsideration for the reasons discussed below. In response to the Examiner's rejection of claims 49, 92 and 111 under 35 U.S.C. §112, second paragraph, Applicants requested that the Examiner consider the following two principles of patent law and precedence:

1. Claim terms are to be given their ordinary dictionary meaning unless the specification shows an express intent on the part of the Applicants to impart a novel meaning to the claim terms (*Kegel Co. v. AMF Bowling, Inc.*, 127 F.3d 1420, 44 USPQ2d 1123 (Fed. Cir. 1997); and

2. Terms such as "substantially," "close to," "about," and the like are ubiquitous in patent claims, and have been accepted and upheld by the Courts for purposes of distinguishing the claimed subject matter from the prior art (*Andrew Corp. v. Gabriel Elec., Inc.*, 847 F.2d 819, 6 USPQ2d 2010, 2012 (Fed. Cir. 1988).

As regards the latter function, the United States Supreme Court itself held in *Graham v. John Deere Co.*, 383 U.S. 133, 148 USPQ 459, 473 (1966) that claims "must be read and interpreted with reference to rejected ones *and to the state of the prior art* . . .." (Emphasis added)

In the present application, it is manifestly clear that Applicants had no intention of creating a special definition of "substantially free." It is clear that in the present invention as claimed herein, in contrast to the teachings of the prior art, a coating giving outstanding crispness, mouth feel and hold time can be obtained without using cornstarch. While cornstarch "may be" optionally included as noted at page 8 of the specification, it is not necessary.

Accordingly, Applicants are using "substantially free of cornstarch" in the claims in its ordinary dictionary sense, for the purpose suggested by the Federal Circuit in *Andrew Corp. v. Gabriel Elec., Inc.*, and by the United States Supreme Court in *Graham v. John Deere Co.*, to distinguish the prior art, all of which teaches that at least 2.0% cornstarch must be used in order to obtain a food coating made from vegetable and/or cereal materials, and especially coatings for potatoes to be fried.

Applying the above legal principles to this case, one looks first to a dictionary such as Webster's New Collegiate Dictionary, which offers the following pertinent definitions:

> "Free: . . . . 9. Devoid; also, outside; beyond."
> "Substantial . . . 5. That is such in substance or *in the main*; as, a substantial victory." (Emphasis added)

Thus, the term "substantially free of cornstarch" as used in the claims means the composition is, "in the main, devoid of cornstarch."

The Federal Circuit Court of Appeals has allowed patentees to use terms such as "substantially free of" because it would be unfair to require a patentee to limit its claims to a composition which is absolutely free of an ingredient, when such a requirement is neither necessary for purposes of operativeness, nor for purposes of distinguishing the prior art. Horn discloses a coating which requires 2% or more of cornstarch. The Federal Circuit has recognized that in circumstances such as this, it would be unfair to require Applicants to craft a

claim which a competitor could avoid merely by adding an insignificant amount of cornstarch, as for example by using baking powder, which includes a small amount of cornstarch. In such a case, the competitor would receive the benefit of refraining from using 2% or more of cornstarch, and yet would avoid infringement.

Accordingly, and consistent with prior decisions of the Federal Circuit Court of Appeals and the United States Supreme Court, it is respectfully submitted that "substantially free of cornstarch" meets the definiteness requirements of 35 USC §112. In the context of the present case, it means that the claimed composition is, "in the main, devoid of cornstarch," such that the present claims do not read on Horn et al. which requires at least 2% cornstarch. It is respectfully submitted that the 35 USC §112 rejection on this ground should be withdrawn.

The Examiner also rejected claims 49-51, 55-57, 61-63, 73-75, 77-79, 81-85, 88-90, 92-98 and 111 under 35 U.S.C. §102(e) as being anticipated by Horn et al. (6,080,434). However, Horn, like other prior art patents disclosing food coatings, requires the use of cornstarch. As noted in the previously submitted Declaration of John Stevens:

> Considered as a whole, the prior art teaches one of ordinary skill in the art the necessity of using cornstarch in food coatings made from vegetable and/or cereal materials, especially coatings for potatoes to be fried . . . all of the patents listed in the "background of the invention" of the . . . patent application are directed to food coatings which include cornstarch. To my knowledge, all commercial vegetable and/or cereal based coatings sold prior to the date of this invention, had included cornstarch.

(Paragraph 11 of Dec. of John Stevens)

As further noted by Mr. Stevens, the Horn reference is no exception, requiring at least 2% cornstarch. Horn is not "in the main, devoid of cornstarch," as is required by the claims of the present application. Accordingly Horn does not anticipate the claims.

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Nor can the Horn patent, which like other prior art vegetable and/or cereal material food coatings teaches the necessity of using cornstarch in the coating, be said to suggest to one of ordinary skill in the art that such coatings can be successfully made which do not require cornstarch. Horn follows the prior art. It is typical of the prior art. It teaches that cornstarch is a required ingredient in such food coatings. In the present invention, it has been found that cornstarch is not necessary, and that successful coatings can be made which are "in the main devoid of cornstarch."

Accordingly, it was respectfully submitted that claims 49-111, as well as new claims 112-117, were not disclosed or suggested by the prior art. Indeed, the prior art teaches away from rice and dextrin food coatings which are substantially free of cornstarch, or which have "about 0 cornstarch," or "which is free of cornstarch."

February 20, 2004 Advisory Action

On February 20, 2004, the Examiner mailed an Advisory Action essentially maintaining her earlier rejection and refusing to enter the amendment to claim 82 and the new claims. The amendments to claim 49, 92 and 111 were entered stating: .

> [t]he amendment to claims 49, 92 and 111 will be entered because the amendment overcomes the 112 first and second paragraph rejections; this will reduce the issue on appeal. The amendment to claim 82 will not be entered because it raises a new isue [sic] and the issue of new matter. The new claims will not be entered for reason [sic] set forth in part (d) above and also they raise new issue [sic].

The Examiner rejected claims 49, 92 and 111 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. It is the Examiner's position that while Applicants state the term "substantially free of corn starch" means "in the main, devoid of corn starch" that the specification "does not give any such meaning." The Examiner also stated:

> Applicant cites the term means "devoid; also, outside; beyond"; what does "substantially devoid means [sic]". The specification

> does not define "substantially free" in fact, the specification disclose [sic], 10% or even more corn starch can be used and the examples disclose 0% corn starch. Thus, it is not clear what range of corn starch is covered with such language.

In the Advisory Action, the Examiner further stated:

> [w]ith respect to the rejections over the Horn et al. reference, applicant argues the term "substantially free of corn starch" mean [sic] "in the main devoid of corn starch" and as such the claims do not read on Horn et al. which requires at least 2% corn starch. The Examiner respectfully disagree [sic] with applicant. Claims are interpreted in light of the specification. Since applicant does not define the amount of corn starch that is considered "substantially free of corn starch", this language is interpreted to mean that the composition can contain small amount [sic] of corn starch. Horn et al. teach 2%; this amount is small in comparison to the other component; thus, the composition is substantially free of corn starch. The specification disclosed as 10 [sic] or even more; this amount is larger than the amount disclosed by Horn et al.

Applicants respectfully disagree with the Examiner's position. In construing claim language, the Federal Circuit first looks "'to the claim language itself to define the scope of the patented invention.'" *Liquid Dynamics Corporation v. Vaughn Co.*, 355 F.3d 1361, 1367 (Fed. Cir. 2004) (*quoting Dow Chem. Co. v. Sumitomo Chem. Co.*, 257 F.3d 1364, 1372 (Fed. Cir. 2001)). As a starting point, the Federal Circuit gives claim terms their ordinary and accustomed meaning as understood by one of ordinary skill in the art. *Id.* at 1367. Dictionaries are always available to aid in the task of determining meanings that would have been attributed by those of skill in the relevant art to any disputed terms used by the inventor in the claims. *Texas Digital Systems, Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1202 (Fed. Cir. 2002). In this case, the Applicants have previously stated the dictionary definition of "substantially free" means "in the main, devoid" of corn starch. The Federal Circuit has also

stated that the intrinsic record also must be examined in every case to determine whether the presumption of ordinary and customary meaning is rebutted. *Id.* at 1204. "Indeed, the intrinsic record may show that the specification uses words in a manner clearly inconsistent with the ordinary meaning reflected, for example, in a dictionary definition." *Id.* In this case, as the Examiner has previously admitted in the Advisory Action that "[t]he specification does not define 'substantially free' . . .."

Finally, in construing the meaning of a term, the Federal Circuit looks to the prosecution history of a patent. *Liquid Dynamics Corporation v. Vaughn Co.*, 355 F.3d 1361, 1367 (Fed. Cir. 2004).

> When we use the prosecution history as a source material, the prior art cited and the applicant's acquiesce with regard to that prior art indicate the scope of the claims, or in other words, what the claims do not cover. *Autogiro Co. of Am. v. United States*, 181 Ct.Cl. 55, 65, 384 F.2d 391 (1967). Furthermore, "whether the patentee has unequivocally disavowed any certain meaning to obtain his patent, the doctrine of prosecution disclaimer attaches and narrows the ordinary meaning of the claim congruent with scope of the surrender."

Id. at 1367-68.

In this case, as is evidenced by the prosecution history of the present application, Applicants acquiesce with regard to the prior art. Applicants have unequivocally disavowed a coating composition containing 2% or more corn starch, and therefore the doctrine of prosecution disclaimer attaches and narrows the ordinary meaning of the claim congruent with the scope of the surrender. Applicants' present claim language terms including "substantially free of corn starch" (independent claims 49, 92, 111 and 119), "about 0% corn starch" (claim 118) and "is free of corn starch" (claims 120-123) are intended to encompass ingredients that contain trivial additions of corn starch, such as baking powder.

We now request that the newly presented claims be considered and note that Applicants have made a concerted effort to place the present application in condition for allowance, and a notice to this effect is earnestly solicited. In the event there are any remaining informalities or any other issues requiring Applicants' assistance, Applicants request the Examiner call the undersigned attorney.

Respectfully submitted,

CHEREE L. B. STEVENS ET AL.

By: Price, Heneveld, Cooper, DeWitt & Litton, LLP

3/26/2004
Date

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